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IN THE

Supreme Court of the United States

October Term, 1945.

No. 1105.

ALMOND A. HEATH,

Petitioner,

vs.

HENRY G. FRANKEL and L. V. FRANKEL,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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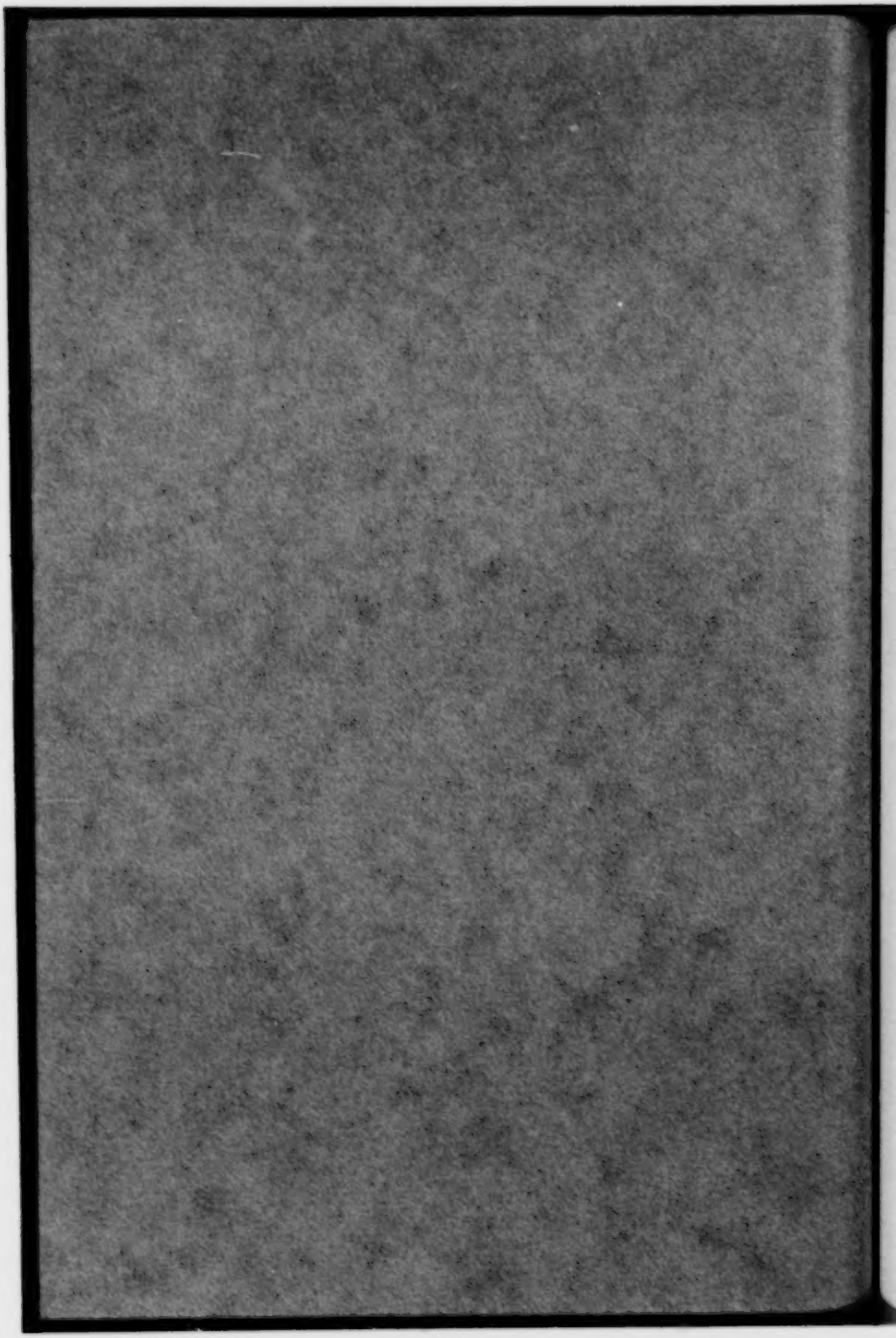

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This case is before this Court on petition for a writ of certiorari to the United States Circuit Court of Appeals for the Ninth Circuit to review a decree of the Circuit Court of Appeals [R. 1067] affirming a judgment [R. 72-75] of the United States District Court for the Southern District of California, Central Division, adjudging Patent No. 1,989,922 and Claims 1 to 10, inclusive, 12, 13, 15, 18 and 19 of Patent No. 2,203,280 invalid and void for want of patentable novelty and invention [R. 67-69; Findings of Fact 11-23].

The oral opinion of the District Court is found at R. 53-56; its Findings of Fact and Conclusions of Law, at R. 65-71; the opinion of the Court of Appeals, at R. 1062-1065, reported in 153 F. (2d) 369.

We submit that this case presents no reason or ground for the grant of certiorari such as is required by Rule 38, subdivision 5, of this Court. No court has sustained any of the patent claims in suit; there is no conflict of decision with respect to the validity of such claims. This Court has uniformly indicated that it will not review concurrent findings of invalidity for want of invention in the absence of any conflicting decision sustaining validity of the claims. In affirming the findings of the trial court that the claims in suit did not involve more than the exercise of ordinary mechanical skill and knowledge and did not require invention, the Circuit Court of Appeals followed and expressly applied the decision of this Court in *Sinclair & Carroll Co. v. Interchemical Corp.*, 89 L. Ed. 1099, and the opinion of the Sixth Circuit Court of Appeals in *Wolverine Fab. & Mfg. Co. v. Detroit Gasket & Mfg. Co.*, 148 F. (2d) 399. The decisions below are not in conflict with the opinions of this Court in *Hazel-Atlas v. Hartford Empire Glass Co.*, 322 U. S. 328, or *Precision Instrument & Mfg. Co. v. Automotive Maintenance Machinery Co.*, 324 U. S. 806.

The petition herein does not seek a review of any of these Findings of Fact or Conclusions of Law respecting the invalidity of said patent claims.

We restate the case only in so far as is necessary to correct inaccuracies and omissions in petitioner's statement with respect to the sole question (Pet. p. 3) for the review of which certiorari is sought.

Statement of the Case.

Petitioner in his original complaint alleged ownership and the grant to him of Patent No. 2,203,280 and infringement thereof by respondents [R. 2-6]. Only the claims adjudged by the District Court and the Court of Appeals invalid, were alleged infringed. Respondents' answer [R. 10-14] denied validity or infringement of Patent No. 2,203,280. Respondent Henry G. Frankel also served and filed his "Counter Claim for Unfair Competition and Cross-Complaint for Declaratory Relief Respecting Letters Patent Nos. 1,989,922 and 2,203,280" [R. 15-30], bringing in as a cross-defendant thereto Milo Harding Co., Ltd., alleging an actual controversy between petitioner and Milo Harding Co., Ltd., and respondent Frankel [R. 16-20] respecting the invalidity of such patents [R. 20-25], denying infringement [R. 25], and alleging unfair competition of petitioner and Milo Harding Co., Ltd. Judgment of invalidity of the patents was prayed, together with an injunction and damages [R. 27-9]. Respondents' answer to the original complaint denied that petitioner was the original and first inventor of anything patented in Patent No. 2,203,280; that the claimed invention had been described in sundry printed publications; and that it had been known and used by sundry persons, including respondent Henry G. Frankel [R. 9-12]. Respondent Henry G. Frankel's counterclaim and cross-complaint similarly alleged the invalidity of Patent No. 1,989,922 for the same reasons [R. 20-23], including the allegation

of prior knowledge and use by respondent Henry G. Frankel.

In making its Findings of Fact or Conclusions of Law respecting the invalidity of the patents, the District Court did not rely upon any of the matters, testimony, or exhibits offered with respect to the allegation of prior knowledge and public use by respondent Henry G. Frankel of the patented invention. The facts found by the District Court and affirmed by the Court of Appeals were proven by the testimony of witnesses having no connection with respondents and by documents and printed publications produced by them.

The District Court said [R. 54]:

> "Referring now to the counterclaim, and to the issue of unfair competition, the court finds in favor of the cross-defendants.
>
> "It is with great regret that the court reached the conclusion—but it was compelled to—that these defendants have come here with unclean hands. I am thoroughly in accord with that position, which has been contended for by the cross-defendants, because of the testimony of Mr. Buys, the expert, which I think conclusively shows that Exhibits Y and Z were fabricated, and under such circumstances, in the opinion of this court, the counterclaimants may not recover."

Therefore the District Court awarded judgment against respondent H. G. Frankel for five hundred dollars ($500) for "the necessary costs and disbursements incurred by

plaintiff in connection with the hiring of plaintiff's handwriting expert, * * *" [R. 74].

No fact creating any estoppel against respondents was presented to or found by the District Court.

Argument.

(a) In view of the concurrent findings of the courts below that the claims in suit are invalid for want of invention, and in the absence of any conflict of decision, this is clearly not a proper case for the grant of a writ of certiorari. This Court has recently announced that it will not disturb concurrent findings as to the validity of patent claims where there is evidence to support them and no conflict of decision. (*Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367; *General Talking Pictures Corp. v. Western Elec. Co.*, 304 U. S. 175; *Tennessee Coal I. & R. Co. v. Muscoda Local No. 123*, 321 U. S. 590).

(b) The case does not present any question of estoppel. This Court has never decided that, because of inequitable conduct or unclean hands, the Court should enter judgment against such defendant that an invalid patent is valid. Neither *Hazel-Atlas v. Hartford Empire Glass Co.* nor *Precision Instrument & Mfg. Co. v. Automotive Maintenance Machinery Co.* involved any such question.

The issue of patent validity was of paramount public interest. It was decided by the courts below upon unimpeached proofs. A review of such decisions is not

here sought by the petitioner. As said by the court in *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co., supra*:

> "In the instant case Automotive has sought to enforce several patents and related contracts. Clearly these are matters concerning far more than the interests of the adverse parties. The possession and assertion of patent rights are 'issues of great moment to the public.' Hazel-Atlas Glass Co. v. Harford-Empire Co., 322 U. S. 238, 246 (61 USPQ 241, 245). See also Mercoid Corp. v. Mid-Continent Investment Co., 320 U. S. 661, 665 (60 USPQ 21, 24); Morton Salt Co. v. Suppiger Co., *supra*; United States v. Masonite Corp., 316 U. S. 265, 278 (53 USPQ 396, 402). A patent by its very nature is affected with a public interest. As recognized by the Constitution, it is a special privilege designed to serve the public purpose of promoting the 'Progress of Science and Useful Arts.' At the same time, a patent is an exception to the general rule against monopolies and to the right to access to a free and open market. The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope. The facts of this case must accordingly be measured by both public and private standards of equity. And when such measurements are made, it becomes clear that the District Court's action in dismissing the complaints and counterclaims 'for want of equity' was more than justified."

Admittedly the question (patent validity) of paramount public interest was correctly decided and adjudged. The petitioner herein does not contend or urge otherwise.

We submit that this case does not present any sufficient reason for the grant of a writ of certiorari within the rulings and practice of this Court. It presents no disputed proposition of patent law, and the decisions below do not conflict with any applicable decision of this Court.

Respectfully submitted,

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